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PRE-APPEAL BRIEF REQUEST FOR REVIEW

Docket Number (Optional)

STL10005

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on March 1, 2006

Signature

Typed or printed name

Mitchell K. McCarthy

Application Number

09/995,206

Filed

November 27, 2001

First Named Inventor

Christopher L. Hill

Art Unit

2837

Examiner

P. Miller

Applicant requests review of the final rejection in the above-identified application. No amendments are being filed with this request.

This request is being filed with a notice of appeal.

The review is requested for the reason(s) stated on the attached sheet(s).

Note: No more than five (5) pages may be provided.

I am the

☐

applicant/inventor.

☐

assignee of record of the entire interest.

See 37 CFR 3.71. Statement under 37 CFR 3.73(b) is enclosed.
(Form PTO/SB/96)

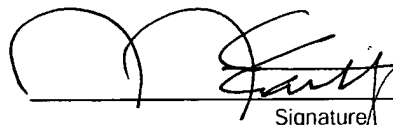
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attorney or agent of record.

Registration number 38,794☐

attorney or agent acting under 37 CFR 1.34.

Registration number if acting under 37 CFR 1.34 _____



Signature

Mitchell K. McCarthy

Typed or printed name

(405) 232-0621

Telephone number

March 1, 2006

Date

NOTE: Signatures of all the inventors or assignees of record of the entire interest or their representative(s) are required. Submit multiple forms if more than one signature is required, see below*.

☐*Total of 1 forms are submitted.

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PATENT
Dkt. STL10005

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re application of: **Christopher L. Hill and Garry E. Korb**
Assignee: **Seagate Technology LLC**
Application No.: **09/995,206** Group Art Unit: **2837**
Filed: **November 27, 2001** Examiner: **P. Miller**
For: **POWER SUPPLY OUTPUT CONTROL APPARATUS AND METHOD**

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Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

APPLICANT'S REMARKS FOR PRE-APPEAL BRIEF REQUEST FOR REVIEW

Sir:

Following are indisputable facts from the record:

1. There are three independent pending claims 34, 41, and 47.
2. All of the independent claims recite either an apparatus or method that compares an observed amount of power to *a profile of said (values/thresholds/levels) that decrease in magnitude during application of power.*
3. FIG. 4 exemplifies illustrative embodiments of the claimed *profile of said values that decrease in magnitude....* (see Examiner's remarks withdrawing the Section 112 rejections, Office Action of 12/1/2005, ppg. 2-3)
3. With respect to the independent claims 31, 41, and 47, Touchton '291 does not disclose the value selected from a *profile of said values that decrease in magnitude during application of power.* (Examiner's remarks in Office Action of 12/1/2005, pg. 5)
4. Applicant has previously argued that the Examiner was only able to supply the *profile of said values that decrease in magnitude* limitation of the claims via improper hindsight reconstruction. (see Applicant's Response of 11/1/2005, pg. 10)

This case turns on whether the Panel agrees with Applicant that a final rejection based upon hindsight reconstruction is not ripe for appeal. Applicant now prays for an objective review of the factual deficiencies of these rejections and withdrawal of the rejections.

IT IS CLEAR ERROR THAT THE EXAMINER HAS NOT SUBSTANTIATED A PRIMA FACIE CASE OF OBVIOUSNESS IN REJECTING INDEPENDENT CLAIMS 34, 41, AND

47

Obviousness under Section 103 is a legal conclusion based on underlying findings of fact. *In re Kotzab*, 217 F.3d 1365, 1369 (Fed. Cir. 2000). If Applicant is incorrect, meaning this case is in fact ready for appeal, then the Panel must find in the underlying facts “substantial evidence” that adequately supports the legal conclusion of obviousness. *In re Gartside*, 203 F.3d 1305, 1316 (Fed. Cir. 2000). This approach is consonant with the Office’s obligation to develop an evidentiary basis for its factual findings to allow for judicial review under the substantial evidence standard that is both deferential and meaningful. *see In re Lee*, 277 F.3d 1338, 1344 (Fed. Cir. 2002).

For a *prima facie* case of obviousness to exist, there must be an objective teaching in the prior art or knowledge generally available to one of ordinary skill in the art that would lead an individual to combine the relevant teachings of the references. *In re Fine*, 837 F.2d 1071, 1074 (Fed. Cir. 1988). The motivation may come explicitly from statements in the prior art, from knowledge of one of ordinary skill in the art, or even in the nature of the problem to be solved. *Kotzab*, at 1370. The presence or absence of motivation is a question of fact, and the evidence that motivation exists must be clear and particular. *In re Dembiczak*, 175 F.3d 994, 1000 (Fed. Cir. 1999).

Generalized statements of advantages or possibilities by an Examiner, without a bona-fide regard to the desirability or feasibility of modifying the cited references, does not meet the evidentiary requirements for substantiating a *prima facie* case of obviousness. Given the subtle but powerful attraction of a hindsight-based obviousness analysis, a rigorous application of the requirement of an evidentiary basis for the motivation must be followed. *In re Dembiczak*, at 999. In so doing the Examiner has at his disposal ample guidance:

The rationale supporting an obviousness rejection may be based on common knowledge in the art or “well-known” prior art. The examiner may take official notice of facts

outside of the record which are capable of instant and unquestionable demonstration as being "well-known" in the art.

In re Ahlert, 424 F.2d 1088, 1091 (CCPA 1970)

When a rejection is based on facts within the personal knowledge of the examiner, the data should be stated as specifically as possible, and the facts must be supported, when called for by the applicant, by an affidavit from the examiner. Such an affidavit is subject to contradiction or explanation by the affidavits of the application and other persons.

37 CFR 1.104(d)(2)

Assertions of technical facts in areas of esoteric technology must always be supported by citation of some reference work...allegations concerning specific knowledge of the prior art, which might be peculiar to a particular art should also be supported....

In re Ahlert, at 1091

In the present case the Examiner has played loose and free with facts and done a lot of hand-waving in an attempt to substantiate the legal conclusion of obviousness. First, the skilled artisan will readily recognize that neither Touchton '291 nor Janonis '580 teach or suggest using a *profile of said values that decrease in magnitude during application of power....*

The Examiner has admitted Touchton '291 is deficient in this regard, but relies merely on the fact that Janonis '580 discloses a processor with an embedded profile algorithm to cure the deficiency. Janonis '580 is wholly silent, however, regarding the embedded profile algorithm providing a *profile of said values that decrease in magnitude during application of power*. Simply because Janonis '580 varies the voltage, and without regard to the feasibility of modifying Janonis '580 to do so, the Examiner concludes obviousness on the generalized statement that Janonis '580 could be modified to provide a profile with values that decrease during application of power. Clearly, however, the Examiner has dodged the issue of what adverse affect such a modification would have on Janonis '580, where the output of the profile algorithm functions to maintain a recommended current. The skilled artisan would readily agree that the output of the profile algorithm would certainly never produce a *profile of said*

values that decrease in magnitude during application of power... if it did, the up/down counter 522 would only have to be a “down counter.”

Similarly, the Examiner clearly ventures beyond the teaching of Touchton ‘291 to generalize a theory that one could invoke some scheme whereby some unnamed threshold value could be changed upon each of the plurality of subsequent reinitialization sequences. Like the generalization of Janonis ‘580, however, the Examiner artfully dodges the real issue by not explaining the circumstances that would reasonably result in the series of reinitializations defining a *profile of said profiles that decrease in magnitude during application of power*. The skilled artisan again would readily agree that, given the Examiner’s hypothetical “changing conditions” theory, the altered thresholds would certainly never produce an ever-reducing profile as claimed.

Applicant now reiterates that the only way the Examiner is able to supply the *profile of said values that decrease in magnitude during application of power* limitation is via improper hindsight reconstruction. The Examiner has not pointed to any passage of either cited reference that supplies this limitation, or that motivates the skilled artisan to modify the cited references accordingly. The Examiner’s generalized statements about operating the cited references according to this limitation would certainly be rebutted by the skilled artisan because the suggested modifications defeat their purposes. The only place the Examiner can find this limitation is by using the Applicant’s disclosure against it to extrapolate the misplaced generalizations from the related art. In this case where the entirety of the legal conclusion of obviousness rests on the Examiner’s generalizations, the Panel must require some concrete evidence in the record to support them rather than relying on what the Examiner views to be “well recognized” or what a skilled artisan would be “well aware of.” *In re Zurko*, 258 F.3d 1379, 1385-86 (Fed. Cir. 2001)

Accordingly, this case is not in condition for appeal due to the unresolved factual issue that the Examiner has relied exclusively on extrapolating beyond what the cited references reasonably teach or suggest with generalized statements of what “could be,” without addressing the adverse consequences of the suggested modifications on the functionality of the references themselves. These extrapolations are not substantiated by evidence in the record whatsoever as to them being obvious to the skilled artisan. Applicant now prays for an

objective review of the factual deficiencies of these rejections and agreement that they form the substance of an improper hindsight reconstruction.

Accordingly, for at least these reasons the Applicant believes this case is not in condition for appeal. Withdrawal of the final rejection of all claims for further prosecution on the merits to completion is respectfully requested.

Respectfully submitted,

By: 

Mitchell K. McCarthy, Registration No. 38,794

Randall K. McCarthy, Registration No. 39,297

Fellers, Snider, Blankenship, Bailey and Tippens, P.C.

100 N. Broadway, Suite 1700

Oklahoma City, Oklahoma 73102

Telephone: (405) 232-0621

Facsimile: (405) 232-9659

Customer No. 33900